



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,961	06/29/2000	James P. Rodrigues	MS 150530.1/40062.69US01	7182
7590 09/08/2005			EXAMINER	
Merchant & Gould PC P O Box 2903 Minneapolis, MN 55402-0903			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,961

Applicant(s)

RODRIGUES ET AL.

Examiner

Eric B. Kiss

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 June 2005 has been entered.

Claims 1-27 are pending.

Response to Arguments

2. Applicant's arguments, see pages 7-9, filed 27 June 2005, with respect to the rejection(s) of claim(s) 1-27 under 35 U.S.C. §103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the judicially created doctrine of obviousness-type double patenting.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 2192

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,754,612 (hereinafter referred to as the '612 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other. The following analysis is intended to be illustrative rather than exhaustive:

The '612 patent claims (in claim 2) such an init module, performance code marker module, and unit module, together with the prescribed execution timeframes, as claimed in instant claim 1. The '612 patent claim differs from the instant claim only in that it recites benchmark timing (it is further noted that instant claim 9 matches '612-patent claim 2 in this respect), a type of run-time internal state and a raw data table, a type of data record.

The '612 patent claims (in claim 3) the init module functionality substantially as claimed in instant claim 2.

The '612 patent claims (in claim 4) the registry key substantially as claimed in instant claim 3.

The '612 patent claims (in claim 5) the conditional collection of run-time substantially as claimed in instant claim 5.

Art Unit: 2192

The '612 patent claims (in claim 6) the generation of a data record substantially as claimed in instant claim 6.

The '612 patent claims (in claim 16) a method version of the claimed system discussed above, substantially similar to instant method claims 13 and 14, wherein instant claim 14 recites the collection of benchmark timing data.

The '612 patent claims (in claim 24) a computer data product version of the claimed system discussed above, substantially similar to instant computer data product claims 18, 19, and 22, wherein instant claim 22 recites the collection of benchmark timing data.

5. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,873,934 (hereinafter referred to as the '934 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other. The following analysis is intended to be illustrative rather than exhaustive:

The '934 patent claims (in claim 1) such an init module, performance code marker module, and uninit module, together with the prescribed execution timeframes, as claimed in instant claim 1. The '934 patent claim differs from the instant claim only in

Art Unit: 2192

that it recites benchmark timing (it is further noted that instant claim 9 matches '934-patent claim 1 in this respect).

The '934 patent claims (in claim 2) the init module functionality substantially as claimed in instant claim 2.

The '934 patent claims (in claim 3) the registry key substantially as claimed in instant claim 3.

The '934 patent claims (in claim 5) the conditional collection of run-time substantially as claimed in instant claim 5.

The '934 patent claims (in claim 6) the generation of a data record substantially as claimed in instant claim 6.

The '934 patent claims (in claim 13) a method version of the claimed system discussed above, substantially similar to instant method claims 13 and 14, wherein instant claim 14 recites the collection of benchmark timing data.

The '934 patent claims (in claim 18) a computer data product version of the claimed system discussed above, substantially similar to instant computer data product claims 18, 19, and 22, wherein instant claim 22 recites the collection of benchmark timing data.

Conclusion

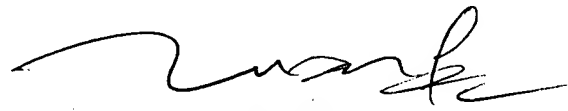
6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist:
571-272-2100.

EBK /EBK
August 31, 2005



TUAN DAM
SUPERVISORY PATENT EXAMINER